

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of

Bernd WENDEROTH et al.

Atty. Ref.: 3557-43

Serial No. 10/536,806

TC/A.U.: 1796

Filed: May 27, 2005

Examiner: OGDEN JR, Necholus

For: COOLANT BASED ON AZOLE DERIVATIVES CONTAINING 1,3-  
PROPANEDIOL FOR FUEL CELL COOLING SYSTEMS

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July 27, 2010

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Request for Reconsideration**

Appellants request reconsideration of the Board decision issued on May 28, 2010, in light of administrative and judicial decisions containing points of law that are believed to have been overlooked. Specifically, Appellants point to two decisions that post-date the Board's decision: *In re Quist*, Appeal No. 2008-001183 (BPAI June 2, 2010)<sup>1</sup> (precedential) and *TriMed, Inc. v. Stryker Corp.*, No. 2009-1423 (Fed. Cir. June 9, 2010),<sup>2</sup> and which require reconsideration of the Board's decision. Specifically, the Board's decision makes no attempt to reassess the entirety of the legal conclusion of obviousness anew in light of the evidence of record.

***In re Quist*, Appeal No. 2008-001183 (BPAI June 2, 2010) (precedential)**

In *Quist*, the Board explained that "if the appellant raises the issue as to whether the examiner's conclusion of obviousness was in error, based in part on the proffered

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<sup>1</sup> Available at <http://www.uspto.gov/ip/boards/bpai/decisions/prec/fd08001183.pdf>.

evidence of secondary considerations, the panel must consider if the examiner erred in determining patentability, *based on the totality of the record*.” Slip op. at 11 (emphasis added). In this case, the Board did not consider the totality of the record.

Instead, the Board improperly framed the issue as whether “Appellants indicated reversible error in the Examiner’s determination that the Appellants’ evidence of unexpected results is insufficient for *overcoming* the prima facie case of obviousness.” (Board Decision at 3 (emphasis added).) But the prima facie case of obviousness was not discussed, mentioned, or analyzed. Accordingly, the Board’s decision failed to follow the subsequent clarification in *Quist* – namely, that the *totality* of the record must be examined. A *prima facie* case is not “overcome” by secondary considerations; the evidence used to create the *prima facie* case is simply reevaluated.

Appellants did not acquiesce to the establishment of a *prima facie* case, rather Appellants merely did “not dispute that the individual components were extant at the time the application was filed.” (Appeal Br. at 11; *compare* Board Decision at 3.) As the Supreme Court commented in *KSR*, “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Put another way, “[o]nly God works from nothing. Men must work with old elements.” *Fromson v Advanced Offset Plate, Inc.*, 755 F.2d 1549, 1556 n.3 (Fed. Cir. 1985) (quotation omitted).

This matters because the Board’s decision never attempts to address the (i) strength of the evidence of the *prima facie* case in conjunction with (ii) the evidence that

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<sup>2</sup> Available at <http://www.cafc.uscourts.gov/images/stories/opinions-orders/09-1423.pdf>.

the cited prior art teaches away from a substantially constant electrical conductivity.

(See, e.g., Appeal Br. at 15.) That is, there is an evidence-based expectation that electrical conductivity will increase over time in similar compositions. Applicant's invention cuts against this evidence-based expectation, and the Board's decision cites to no evidence that persons having ordinary skill in the art would have expected results like the results evidenced in the specification.

Accordingly, reconsideration is requested in light of *Quist*.

**TriMed, Inc. v. Stryker Corp., No. 2009-1423 (Fed. Cir. June 9, 2010)**

In *TriMed*, the Federal Circuit emphasized the need for evidence to support a conclusion of obviousness. In reversing a district court's grant of summary judgment of invalidity, the court remarked that "[m]erely saying that an invention is a logical, commonsense solution to a known problem does not make it so." Slip op. at 15. In this case, the Board has provided no examination of the prima facie case nor of all evidence (including the evidence showing that there is an expectation in the prior art that electrical conductivity should increase over time) in affirming the conclusion of obviousness.

Accordingly, reconsideration is requested in light of *TriMed*.

**CONCLUSION**

Appellants request reconsideration of the it is believed that the application is in clear condition for allowance; therefore, early reversal of the Final Rejection and passage of the subject application to issue are earnestly solicited.

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Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:                     /Gordon Klancnik/                      
Gordon P. Klancnik  
Reg. No. 50,964

GPK:lmj  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100